

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the U.S. Patent Application of

Thomas BREITBACH et al.

Examiner: Lu, Zhyu

Serial No.: 09/936,834

Art Unit: 2618

Date Filed: September 17, 2001

Docket No.: P-44 MG

Confirmation No.: 1508

Title: Method for Using Standardized Bank Services via the Internet

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR CLARIFICATION OF OFFICE ACTION AND
REQUEST FOR WITHDRAWAL OF FINALITY**

Sir:

On December 26, 2006, applicants filed a Request concerning additional references utilized by the Examiner and asked for correction due to the confusion caused by the additional references. Applicants gratefully acknowledge the Office Action mailed March 15, 2007 in response to the Request. However, instead of clarifying the rejections, the Office Action confusingly makes assertions based on additional references in the rejection of claims 1 and 21, while simultaneously and inconsistently stating that the references are not relied upon in the rejection. Also, the most recent Office Action is made final despite the fact that the grounds of rejection of claim 1 has been changed to include "Official Notice" of a claimed limitation. Applicants therefore request that: 1) the rejections of claims 1 and 21 be clarified; and 2) that the finality of the Office Action be withdrawn.

Background

In the previous Office Action dated September 26, 2006, the Response to Arguments section relied upon a “relevant reference” entitled “At the Coal-face between Financial Industries and Politics: An Interview with the Financial Issues Working Group’s Chairman Charles Goldfinger” (hereafter “the “Interview Reference”) with respect to the rejection of claims 1 and 21. However, the rejection of claims 1 and 21 in part 2 on pages 4-7 of the Office Action was not changed accordingly, and did not mention the Interview Reference. A Request was filed by applicants on December 26, 2006 requesting that the inconsistency be corrected so that the rejection would be clear.

The Request of December 26, 2006 also noted that the rejection asserted (for the first time) that HBCI "provides support for multibanking, platform independent, and DES- and RSA-encryption and signatures for chip card"; "provides more security and banking functions"; and is "providing more banking functions and support" than the Telepay system described in the Hultgren patent. Neither the Hultgren patent nor the HBCI specification was relied upon for these assertions. At that time, the reference being relied upon as support for the assertions was unknown to applicants, but as would later be discovered, was known to the Examiner and not cited in the Office Action. Therefore, the filed Request also requested correction of this oversight so that the rejection could be traversed.

In a telephone interview subsequent to the request, the Examiner indicated that he had consulted the Wikipedia entry for HBCI when preparing the Office Action of September 26, 2006 and faxed a copy to attorney for applicants. It is this online document which states that HBCI “provides support for multibanking, platform independent, and DES- and RSA-encryption and signatures for chip card.”

The present Office Action dated March 15, 2007 rejects claim 1 under 35 USC 103(a) as being obvious over U.S. Patent No. 6,868,391 issued to Hultgren (hereafter “the Hultgren patent”) (see pages 4-5). The present obviousness rejection of claim 1 is different than the obviousness rejection of claim 1 in the previous Office Action dated September 26, 2006 insofar as at page 5, line 7, the present rejection “takes ‘Official Notice’ that the claimed limitation is well known in the art”. The rejection also includes the assertion that HBCI “provides support for multibanking, platform independent, and DES- and RSA- encryption and signatures for chip card” based on the online Wikipedia document. The Response to Arguments in part 2 of the present Office Action includes both this assertion and other allegations regarding HBCI (see page 2).

A curious paragraph appears at the top of page 4 of the Office Action. It states that the Examiner never disclosed the online document and the Interview Reference to be references in the rejection. Indeed, the online document was not disclosed to applicants in the previous Office Action, and that is part of the concern and the cause for the confusion. The paragraph goes on to state that the additional references are only used to indicate the definition of HBCI and its well known usage, which explains the obviousness rejections. However, the statement is unavailing. HBCI was well known. Indeed, it was cited by applicants in the background portion of the specification, and the actual HBCI specifications themselves are of record in this application.

Request for Clarification of Rejections

As noted above, the rejection of claims 1 and 21, and the Response to Arguments, in the Office Action include assertions that have their basis for support in the additional references. However, on the other hand, the top of page 4 states that these references are not part of the

rejections of claims 1 and 21. Thus, the Office Action is inconsistent and applicants request clarification so the inconsistency is removed. Pursuant to MPEP 710.06, applicants request that they have at least one month in which to respond to the clarification.

If the rejection is not going to rely on these two additional references, then the assertions based on them should be removed so this is clear. Specifically, the paragraph bridging pages 2-3 related to the Interview Reference should be removed, and the assertions of support multibanking, platform-independent, and encryption and signatures for chip card on page 2 and on page 5 based on the online Wikipedia entry should be removed. On the other hand, if the additional references are going to be relied upon then the paragraph to the contrary at the top of page 4 should be retracted.

Request for Withdrawal of Finality

Applicants respectfully submit that the finality of the outstanding Office Action should be withdrawn because the grounds of rejection for claims 1 and 21 have been changed in the Office Action. The grounds of rejection for claims 1 and 21 in the previous Office Action dated September 26, 2006 did not refer to, or include assertions based on, the online Wikipedia entry for HBCI. Nor did the previous grounds of rejection take “Official Notice” that a claimed limitation was well known in the art.

Despite the statement at the top of page 4 that the online Wikipedia entry for HBCI is not being relied upon as a reference, the rejection of claims 1 and 21 in fact contains assertions that are taken directly from the language of the online Wikipedia entry. These assertions are not alleged to be supported by any other reference. Thus, the reference is in fact being relied upon in making the rejection, and this fact is not altered by a mere statement to the contrary.

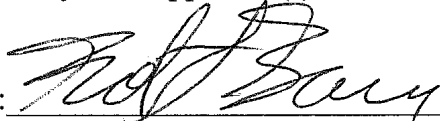
Applicants traversed the previous rejection of claim 1 because it was believed that all of the claim limitations were not suggested by the Hultgren patent, the only reference applied in the rejection. The Office Action now takes "Official Notice" of one of the limitations. Even though applicants were correct in their traversal of the previous rejection, the change in the grounds of rejection makes the traversal no longer applicable.

The use of Form Paragraph 7.39 making the Office Action final is only appropriate when the grounds of rejection do not change. Since the grounds of rejection have changed for claims 1 and 21, and applicants will have to respond to the new grounds of rejection in order to traverse the rejections of claims 1 and 21, it is not appropriate to make the Office Action final. See MPEP 706.07.

Dated: June 15, 2007

Respectfully submitted,

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